

Remarks

The April 30, 2009 Office Action for the above referenced application contains rejections of the pending claims on the basis of nine references. The nine references are:

1) U.S. Patent 4,989,141 (hereinafter Lyons) which teaches a previously disclosed method for manipulating information from financial schedules. Lyons provides additional evidence of the novelty, non-obviousness and newness of the claimed invention in a number of ways including:

- 1) by teaching a system that is limited to supporting a user's manipulation of financial schedule information. By way of contrast, the innovative system of the present invention (and all Asset Trust applications) transform data describing a physical object into a different thing, and
- 2) teaching a system that would be have its intent, function and purpose destroyed by modification to match the functionality of the claimed invention.

2) U.S. Patent 5,245,696 (hereinafter Stork) which teaches previously disclosed information the discovery of interrelationships between nature (as mediated by evolution and genetic algorithms) and nurture (as mediated by gradient-descent supervised learning) in a population of neural networks for pattern recognition. Stork provides additional evidence of the novelty, non-obviousness and newness of the claimed invention in a number of ways including:

- 1) by teaching a system that utilizes only neural networks; and
- 2) by teaching an invention that would have its intent, function and purpose destroyed by modification to match the functionality of the claimed invention.

3) U.S. Patent 6,192,354 (hereinafter Bigus) which teaches a method for utilizing a plurality of intelligent agents suited to perform the computer task but having varied degrees of domain knowledge. Bigus provides additional evidence of the novelty, non-obviousness and newness of the claimed invention in a number of ways including:

- 1) by teaching a system that utilizes a plurality of intelligent agents perform a computer task where the agents have varied degrees of domain knowledge; and
- 2) by teaching an invention that would have its intent, function and purpose destroyed by modification to match the functionality of the claimed invention.

4) U.S. Patent 6,549,922 (hereinafter, Srivastava et al) which teaches an extensible framework for the automatic extraction and transformation of metadata into logical annotations. Srivastava has no known direct relevance to the instant application as it teaches a method for

metadata extraction and transformation that is simply not used in the instant application. Srivastava does mention the term “metadata mapping” however the term is used in a way that teaches away from the claimed methods as it is used to describe the mapping of extracted and summarized metadata annotations to a schema. By way of contrast, the innovative system of the present invention uses the term “metadata mapping” to describe the mapping of database metadata from a plurality of sources to a central database metadata. The lack of relevance was confirmed by a previously provided declaration.

5) U.S. Patent 7,249,328 (hereinafter Davis) which teaches previously disclosed methods for preparing and presenting data in tables and graphs using a combined browser spreadsheet application. Data is prepared by identifying the changes require to convert data to a common dtd and storing the set of identified changes in a separate database. When data are required for presentation and manipulation by the browser-spreadsheet application, the data are retrieved from their original locations, and combined with the stored set of changes. Similar methods for preparing and presenting data were already disclosed in the Bowman Amuah and Ranger patents. Bowman Amuah also disclosed the combined preparation and manipulation of data and that smil was going to replace xml. Davis provides additional evidence of the novelty, non-obviousness and newness of the claimed invention in a number of ways including:

- a) Davis reinforces the previously disclosed teachings of Bergstrom and Widom that the limitations of dtd’s that make them generally unsuitable for use in enterprise processing. Davis does this by teaching the use of xml for formatting of data for graphs and tables. Davis also reinforces Ranger’s teaching that xml is only suitable for presentations.
- b) Davis does not create an integrated database and is not capable of creating one. By way of contrast, the innovative system of the present invention transforms data into an integrated database in accordance with a xml and common schema where it can be retrieved and used by any application.

As the above discussion and the previously filed declaration make clear, Davis does not have any relevance to the claimed inventions. The Assignee notes that the Examiner has also failed to consider the other references identified by the previous Examiner that provide substantial additional evidence of the novelty, non-obviousness and newness of the claimed invention.

6) A reference by Baur et al (hereinafter Baur) that teaches that discounts on closed end funds is a potential proxy for investor sentiment and that an analysis of changes in the S&P 500

index over a time period in the 1980's did not show a statistically significant relationship between this proxy and the actual index price changes. In accordance with the specification for the instant application, the investor sentiment proxy would be a potential market value factor. The Baur document did confirm that one of the potential market value factors identified in the specification (interest rates) is relevant to market price changes. As the above discussion and the previously filed declaration make clear, the Baur document does not have any relevance to the claimed invention.

7) "How to sort out the premium drivers of post-deal value"; Mergers and Acquisitions; July/August 1993, Vol. 28, Iss.1; pg. 33, 5 pgs by Daniel W. Bielinski (hereinafter, Bielinski) that teaches the use of Value Based Management (hereinafter, VBM). Bielinski provides additional evidence of the novelty, non-obviousness and newness of the claimed invention in a number of ways including:

a) Bielinski teaches away from the cash flow analysis method of the claimed invention by teaching a strict reliance on analyzing historical cash flow. By way of contrast, the innovative system and method described in the above referenced application (and all Asset Trust applications) relies on the fact that expected future cash flows may contribute to business value.

Table 1: Operating Cash Flow Sensitivity (from Bielinski)

| | 1987 | 1988 | 1989 | 1990 | 1991 |
|----------------------|--------------------|--------------------|--------------------|--------------------|--------------------|
| Sales | \$7,300,000 | \$7,000,000 | \$7,900,000 | \$8,200,000 | \$9,000,000 |
| Raw Material | <u>\$2,000,000</u> | <u>\$1,600,000</u> | <u>\$1,900,000</u> | <u>\$2,000,000</u> | <u>\$2,300,000</u> |
| Value Added | <u>\$5,300,000</u> | <u>\$5,400,000</u> | <u>\$6,000,000</u> | <u>\$6,200,000</u> | <u>\$6,700,000</u> |
| HR | \$2,500,000 | \$2,600,000 | \$2,700,000 | \$2,700,000 | \$3,000,000 |
| Tech/Capital | \$400,000 | \$600,000 | \$650,000 | \$780,000 | \$800,000 |
| Other | <u>\$250,000</u> | <u>\$225,000</u> | <u>\$240,000</u> | <u>\$210,000</u> | <u>\$260,000</u> |
| Gross Margin | \$2,150,000 | \$1,975,000 | \$2,410,000 | \$2,510,000 | \$2,640,000 |
| SG&A | \$1,600,000 | \$1,700,000 | \$2,100,000 | \$2,200,000 | \$2,400,000 |
| Other | <u>(\$14,000)</u> | <u>(\$6,000)</u> | <u>(\$25,000)</u> | <u>(\$10,000)</u> | <u>(\$40,000)</u> |
| Operating Income | \$536,000 | \$269,000 | \$285,000 | \$300,000 | \$200,000 |
| Taxes | \$60,000 | \$25,000 | \$25,000 | \$15,000 | \$20,000 |
| Depreciation | <u>\$250,000</u> | <u>\$300,000</u> | <u>\$375,000</u> | <u>\$350,000</u> | <u>\$400,000</u> |
| Cash Flow | <u>\$726,000</u> | <u>\$544,000</u> | <u>\$635,000</u> | <u>\$635,000</u> | <u>\$580,000</u> |
| Change in NWC | (\$56,000) | \$200,000 | (\$467,000) | \$293,000 | \$1,000 |
| Capital Expenditures | \$400,000 | \$200,000 | \$550,000 | \$450,000 | \$375,000 |
| Operating Cash Flow | \$382,000 | \$144,000 | \$552,000 | (\$108,000) | \$204,000 |

b) As shown above, Bielinski teaches away from the data analysis method of the claimed invention by characterizing a business with summary level financial statement schedule data and data that can be derived from financial statement data (see Table 2 from Bielinski for additional examples). By way of contrast, the innovative system and method described in the above referenced application teaches and relies on transforming data representative of the business organization including element of value data, transaction data and financial statement data into a model of the physical entity (the business) and uses that model for a variety of things including financial management and value optimization.

c) Bielinski teaches away from the market efficiency assumptions implicit in the claimed invention by teaching the standard valuation model. By way of contrast, the innovative system and method described in the above referenced application (and all Asset Trust applications) teaches and relies on the fact that market sentiment may contribute to business value. Market sentiment is defined as the difference between the market value of the business enterprise and the value of the non-sentiment categories (or segments) of value within the enterprise.

| Table 2: Key Factor Cash Flow Sensitivity (from Bielinski) | | |
|---|--------------------------|---|
| Cash Flow/Value Driver | Sensitivity Range | Cumulative Historical Cash Flow % Change |
| Sales Growth % | +5% -5% | + 84% - 76% |
| Raw Material Cost (% reduction in material cost) | -5% +5% | + 25% - 25% |
| Production HR (%) reduction in HR cost) | - 1% + 10% | + 7% - 70% |
| Inventory Turnover | + 1 Turn - 1 Turn | +1% -1% |

d) Bielinski teaches away from value creation model incorporated within the claimed invention by teaching that there is one way to change business value: change the value of period cash flow.

| Value change per 09/764,068 | Value change per Bielinski |
|--|-------------------------------------|
| 1. Change value of cash flow, 2. Change value of elements of value, | 1. Change value of period cash flow |

| | |
|--|--|
| 3. Change value of growth options & 4. Change value of market sentiment | |
|--|--|

By way of contrast, the innovative system and method described in the above referenced application (and all Asset Trust applications) teaches and relies on the fact that there are at least four ways to change value between one point in time and another point in time: change the value of cash flow, change the value of the elements of value, change the value of growth options and change the value of market sentiment. A comparison of these teachings is summarized in the table above.

e) Bielinski teaches away from the claimed invention by teaching a meaning for the term “value driver” that is different from the definition used in the specification for the claimed invention. Bielinski teaches that value drivers are high level summaries of enterprise financial performance like operating profit margin and that operational value drivers are sub-components of value (raw material cost and/or production labor cost, see Table 2 copied from Bielinski above and the Table below), and/or summary financial statistics, (i.e. sales growth rate and inventory turnover, which are derived from financial statement schedule data).

| Aspect of financial performance | Designation per 09/764,068 | Designation per Bielinski |
|---------------------------------|--------------------------------|---------------------------|
| Raw material cost | Sub-component of expense value | Operational value driver |
| Production labor cost | Sub-component of expense value | Operational value driver |

By way of contrast, value drivers are defined in the specification for the claimed invention as element of value performance indicators that are causal to changes in: components of value (revenue, expense and capital change) and/or market value.

f) Bielinski teaches away from the claimed invention by teaching an invention that would have its intent, function and purpose destroyed by modifying the single tree that calculates actual cash flow and contributions to cash flow for different areas to match the claimed invention which uses a separate model for calculating a percentage contribution from each element and calculates the overall impact by multiplying the percentage contribution by the actual cash flow (or revenue, or expense, etc.).

g) Bielinski teaches away from the modeling method of the claimed invention by teaching

VBM which relies on the tree based analysis of cash flow. By way of contrast, the innovative system and method described in the above referenced application teaches and relies on a predictive model based analysis of revenue, expense, capital change, market sentiment and cash flow. In addition to using different algorithms, there are other differences in the modeling methods used by Bielinski that provide additional evidence of novelty, non-obviousness and newness, including:

1) different assumptions – as is well known to those of average skill in the art, the tree based analysis method used by Bielinski combines the inputs to each node in a linear fashion and passes on the result of the linear combination to the next level in the tree (see Table 2 for confirmation). By way of contrast, the innovative system and method described in the above referenced application teaches and relies on linear and non-linear predictive models to analyze data inputs.

2) different levels – as discussed previously, Bielinski teaches a different definition for the term “value driver”. Consistent with this different definition, Bielinski teaches the use of different levels of aggregation for modeling cash flow than those used in the above referenced application. The levels used by Bielinski are:

- a) First level – Sub-components of value & ratios
- b) Second level – Summary business financial measures
- c) Third level - Cash flow
- d) Fourth level – Value change

By way of contrast, the innovative system and method described in the above referenced application teaches the use of two different layers for cash flow modeling and places one of the layers used by Bielinski in a different position in the hierarchy.

- a) First level – Element of value performance indicators (value drivers)
- b) Second level – Elements of value (i.e. brands, customers, vendors, etc.)
- c) Third level - Components and sub-components of value (i.e. material cost)
- d) Fourth level - Cash flow
- e) Fifth level – Value Change

3) different data input identification method – as is well known to those of average skill in the art, the financial statement data input to each node of the tree based analysis are determined by the user. By way of contrast, the innovative system and method described in the above referenced application teaches and relies on an innovative and

objective variable selection algorithm to identify the data used to complete the modeling.

g) Bielinski teaches away from the method for identifying value improvements described in the above referenced application by teaching sensitivity analysis (see Bielinski Table 2) and break even analysis (see Bielinski Table 3) to identify improvements. By way of contrast, the innovative system and method described in the above referenced application (and all Asset Trust applications) rely on simulated changes and/or optimization analyses to determine which value improvements are the most valuable.

| Table 3: Break-Even Key Factor Tradeoffs (from Bielinski) | | |
|--|--------------|-----------------------------|
| Sales Growth % | Gross Profit | Historical Cash Flow Change |
| + 1% | - 0.50% | ~ 0% |
| + 3% | - 1.50% | ~ 0% |
| + 5% | - 2.50% | ~ 0% |
| - 5% | + 3.00% | ~ 0% |
| - 3% | + 1.75% | ~ 0% |
| - 1% | + 0.50% | ~ 0% |

8) A reference by Cleland et al (hereinafter Cleland) that discloses the previously disclosed concept regarding the primacy of customer value and teaches away from the claimed invention by teaching that customer value is the sole determinant of shareholder value and by teaching away from the claimed invention in a number of other ways.

9) A reference by Mauboussin that was previously disclosed by the Assignee and which teaches away from the claimed invention in a number of ways.

Taken as a whole the selection of the nine references described above also provides substantial evidence that those authoring the April 30, 2009 Office Action for the above referenced application appear to lack the capability of understanding the scientific and engineering principles applicable to the pertinent art. No one who understood the scientific and engineering principles applicable to the pertinent art would ever suggest any of the references described above in an attempt to render the claimed invention obvious. The references appear to have been selected because they contained a few words or “word pairs” that were the same as those in the claims and not because the provided evidence of obviousness and/or anticipation. The Assignee notes that:

1. the Examiner who chose the references was apparently unaware of the fact that the relevant portions of the references had previously been disclosed, and

2. the cited references provide substantial evidence of the novelty and non-obviousness of the claimed inventions by teaching away from all the claimed methods and/or failing to teach any of the claimed methods.

35 U.S.C. §101 rejections

In the April 30, 2009 Office Action claims 36 – 45, 55 – 65 and 67 - 74 are rejected under 35 USC §101 for being non statutory. The Assignee respectfully traverses the rejections for non statutory subject matter in four ways. First, by noting that the April 30, 2009 Office Action has failed to establish a prima facie case of non-statutory subject matter. As noted in MPEP 2106 *"the burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation."*(See, e.g., *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)). In spite of this well known requirement, the Examiner has made unsupported conclusory statements regarding patentability without providing the required explanation or evidence. In particular the Examiner has failed to explain why the claims are non statutory after considering the fact that the Supreme Court has specifically stated "[a] process may be patentable irrespective of the particular form of the instrumentalities used" (*Cochrane v. Deener*, 94 U. S. 780. Furthermore, the claim rejections can be traversed by noting that the human mind is only capable of manipulating four variables at a time with an acceptable degree of accuracy and regularity (see Halford for confirmation). In so far as all claimed inventions require the simultaneous manipulation of a number of variables orders of magnitude greater than four, the assertion that the claimed inventions describes a mental process is clearly and simply incorrect. These assertions provide additional evidence that those authoring the April 30, 2009 Office Action for the above referenced application appear to lack the capability of understanding the scientific and engineering principles applicable to the pertinent art.

The Assignee also traverses the claim rejections by noting that: the claim rejections are non-statutory and that the claim rejections fail under both standards of the APA. Finally, the Assignee notes that the claimed invention clearly meets the legal requirements for statutory subject matter.

35 U.S.C. §102 rejections

In the April 30, 2009 Office Action claims 46, 48, and 53 - 54 were rejected under 35 USC §102 as being anticipated by Bielinski. The Examiner has cited the Bielinski document as a reference. The Assignee respectfully traverses the rejections for anticipation in two ways. First, by noting that the rejections fail under both standards of the APA. Second, by noting that the Office Action has failed to establish a prima facie case of anticipation for the rejected claims. More specifically, the Office Action fails to establish a prima facie case of anticipation in as many as four separate ways for every rejected claim. The first way in which the April 30, 2009 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to describe every element of the rejected claims. MPEP 2131 notes that: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The second way in which the April 30, 2009 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to provide the same level of detail that is present in the claim. MPEP 2131 notes that anticipation requires that: "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The third way in which the April 30, 2009 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the Office Action does not describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in the Davis document. MPEP 2112 notes that: "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fourth way in which the April 30, 2009 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the cited prior art does not enable the completion of a single claim as considerable experimentation would be required to unlearn all the methods taught by Bielinski. After the extensive experimentation revealed the fact that all Bielinski methods have serious shortcomings and should be forgotten (or unlearned), there would still be an additional need for across the board experimentation to discover the methods disclosed in the instant application. The Assignee notes that there are still other ways to traverse these claim rejections. As is well known, in order to anticipate under 35 U.S.C. § 102

– the reference must not only disclose all elements of the claim within the four corners of the document, but it must also disclose those elements "arranged as in the claim" (Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Bielinski does not have all the elements and it does not arrange them in the same manner disclosed in any of the claims.

35 U.S.C. § 103 Rejection of Claims

In the April 30, 2009 Office Action, claims 36 – 39, 41 – 43, 45, 47, 55 and 58 - 63 are rejected under 35 USC §103 as being unpatentable over Bielinski alone or in view of Baur. The Examiner has cited these two documents as references. In the April 30, 2009 Office Action, claims 40, 44, 56 and 57 are rejected under 35 USC §103 as being unpatentable over Bielinski in view of Baur and: Bigus (claim 40), Davis (claim 44), Mauboussin (claim 56) and Davis (claim 57). The Assignee respectfully traverses the §103 rejections of claims 36 –45, 47, 55 and 56 - 63 in two ways. First, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: by: citing combinations of documents that teach away from the claimed invention as discussed on pages 11 through 17 of this paper, citing a combination of documents that fails to teach one or more limitation for every claim as discussed on pages 11 through 17 of this paper, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 49, 50, 51 and 52 are rejected under 35 USC §103 as being unpatentable over Bielinski and Mauboussin (claim 49, 51 and 52) and Stork (claim 50). The Examiner has cited these three documents as references. The Assignee respectfully traverses the §103 rejections of claims 49, 50, 51 and 52 in two ways. First, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: by: citing combinations of documents that teach away from the claimed invention as discussed on pages 11 through 17 of this paper, citing a combination of documents that fails to teach one or more limitation for every claim as

discussed on pages 11 through 17 of this paper, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 72 - 75 are rejected under 35 USC §103 as being unpatentable over Bielinski in view of Baur and Lyons. The Examiner has cited these three documents as references. The Assignee respectfully traverses the §103 rejections of claims 72 - 75 in two ways. First, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: citing combinations of documents that teach away from the claimed invention as discussed on pages 11 through 17 of this paper, citing a combination of documents that fails to teach one or more limitation for every claim as discussed on pages 11 through 17 of this paper, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

In the April 30, 2009 Office Action, claims 64 – 65 and 67 - 69 are rejected under 35 USC §103 as being unpatentable over Davis given Bielinski and claims 70 and 71 are rejected on the basis of Davis in view of Srivastava. The Examiner has cited these documents as references. The Assignee respectfully traverses the §103 rejections of claims 64 – 65 and 67 – 71 in two ways. First, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Second, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. The April 30, 2009 Office Action fails to establish the required prima facie case of obviousness in a number of ways, including: citing combinations of documents that teach away from the claimed invention as discussed on pages 11 through 17 of this paper, citing a combination of documents that fails to teach one or more limitation for every claim as discussed on pages 11 through 17 of this paper, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

The Assignee notes that there are other ways to traverse all rejections under 35 USC §103 and notes that the Examiner appears to attempting to reject the application on the basis of a non-existent standard for obviousness – “mentions the same word pairs as another document” instead of “teaches or suggests all claim limitations. The latter statement was made because all the cited documents teach away from the claimed methods.

35 U.S.C. §112 first paragraph rejections

In the April 30, 2009 Office Action claims 64 - 65 and 67 - 71 are rejected under 35 USC §112 first paragraph. The Assignee traverses the claim rejections by noting that the evidence required to support the prima facie case that would sustain the claim rejections has not been provided. *“A description as filed is presumed to be adequate; unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:*

(A) Identify the claim limitation at issue; and

(B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.”

The arguments presented in the November 12, 2008 Office Action fail to establish the prima facie case required to sustain a §112 first paragraph rejection for a single claim in at least four ways:

1. No new matter has been introduced. The specification describes a process for developing an application database that comprises an integrated database. The integrated, application database comprises the output of the process. As such, the specification describes the development and output of an integrated database and no new matter has been introduced. Furthermore, U.S. Patent 5,615,109 which is incorporated by reference also describes the development of an integrated database.

2. No experimentation is required. It is well established that “the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). More recently in *Invitrogen Corp. v. Clontech Labs, Inc.*, 429 F.3d 1052, 1058 (Fed. Cir. 2005), the Court referenced *Engel Industries, Inc. v. Lockformer Co.* 946 F.2d 1528 (Fed. Cir. 1991) and concluded that “the enablement requirement is met if the description enables any mode of making and using the claimed invention”. The specification describes the development of a database for a physical object – an organization. The Examiner has not identified any reason why this description can not be used to develop and output a database for any physical object or substance.

3. The use of a term in a claim that is not used in the specification is not a statutory basis for rejection.

35 U.S.C. §112 second paragraph rejections

In the April 30, 2009 Office Action claims 55 – 63 and 70 - 71 are rejected under 35 USC §112 second paragraph. The Assignee traverses the claim rejections by noting that the evidence required to support the prima facie case that would sustain the claim rejections has not been provided. MPEP 2173.02 states that: *definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

(A) *The content of the particular application disclosure;*

(B) *The teachings of the prior art; and*

(C) *The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.*

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). The arguments presented in the April 30, 2009 Office Action fail to establish the prima facie case required to sustain a §112 second paragraph rejection in at least five ways:

1. By failing to present any evidence that the claims are indefinite. The April 30, 2009 Office Action only contains conclusory statements that what it means to output a database is not clear and that it is not clear what the identified data is in claim 55.
2. By failing to establish that the rejected claims meet any of the well established criteria for indefiniteness. Specifically, the rejected claims do not: (1) recite a means-plus-function limitation without disclosing corresponding structure in the specification; (2) include a numeric limitation without disclosing which of multiple methods of measuring that number should be used; (3) contain a term that is completely dependent on a person's subjective opinion, and/or (4) contain a term does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007)).
3. By failing to consider the teachings of the prior art. The terms used in the rejected claims have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004).
4. By failing to consider the content of the application disclosure. The metes and bounds of the claims are clearly defined by the specification. In particular, the Assignee notes that the portion of data being transformed in claim 55 is specifically defined and that claim 70 describes a process for developing a database. As such the database comprises the output of the process.
5. By failing to consider the claim interpretation by one possessing the ordinary or average skill in the pertinent art. The relevant Office Action does not contain any evidence that a person of ordinary skill in the pertinent arts would have any confusion about the scope of any of the claims. As described above, it does contain substantial evidence that those authoring the claim rejections do not have an ordinary or average level of skill in the pertinent arts. While not required, an amendment to claim 55 corrects a typo and obviates many of the claim rejections.

Request for Correction

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with

knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent application bears no resemblance to the patent application examination standards dictated by statute and precedent. This activity may be part of an effort to justify the allowance of a number of apparently invalid patents to large companies for similar subject matter. Prompt correction is requested.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons a few claims was amended was to inadvertent correct clerical errors and to put the claims into final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
Date: June 30, 2009